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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,870	01/31/2001	Geoffrey D. Ralston	17887-008100US	3151
20350	7590	04/23/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			BARQADLE, YASIN M	
		ART UNIT	PAPER NUMBER	
		2153		
DATE MAILED: 04/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/774,870	RALSTON ET AL.
	Examiner	Art Unit
	Yasin M Barqadle	2153

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 January 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 4&5.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Claims 1-20 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-14, 16-18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Pace et al U.S. Patent No. (6460050).

As per claim 1, Pace et al teach a method for detecting electronic text communication distributed in bulk, the method comprising steps of

receiving a first electronic text communication [email message are received col. 3, lines 33-41];

processing the first electronic text communication with an algorithm to

produce a first fingerprint [hashing algorithm is used to produce digital identifiers col. 3, lines 41-44 and lines 65-67];

beginning a time period for the first electronic text communication [message IDs' arrival are time and recorded col. 6, lines 2-17];

receiving a second electronic text communications [col.3, lines 65 to col. 4, line 29 and col. 5, lines 14-17];

processing the second electronic text communications with the algorithm to produce a second fingerprint [col. 3, lines 65 to col. 4, line 29 and col. 5, lines 14-17];

comparing the first fingerprint to the second fingerprint to determine if the first electronic text communication is similar to the second electronic text communication [col. 2, lines 43-56 and col. 6, lines 2-17];

updating a count for the first electronic text communication based upon the comparing step [col. 6, lines 63 to col. 7, line 17]; and

Art Unit: 2153

determining if the count during the time period reaches a first threshold [col. 6, lines 2-17 and col. 6, lines 63 to col. 7, line 17].

As per claim 2, Pace et al teach the method for detecting electronic text communication distributed in bulk as recited in claim 1, further comprising a step of filtering subsequent electronic text communications similar to the first electronic text communication [col. 6, lines 2-17 and col. 6, lines 63 to col. 7, line 17].

As per claim 3, Pace et al teach the method for detecting electronic text communication distributed in bulk as recited in claim 1, wherein the first listed processing step comprises a step of calculating a histogram where counts are determined for words in the first electronic text communication [col. 6, lines 2-65].

As per claim 4, Pace et al teach the method for detecting electronic text communication distributed in bulk as recited in claim 1, further comprising steps of:

determining if a character count of the first electronic text communication exceeds a second threshold [col. 6, lines 2 to col. 7, line 4]; and

choosing a fingerprint algorithm based upon the step of determining if the character count of the first electronic text

Art Unit: 2153

communication exceeds the second threshold [col. 6, lines 2 to col. 7, line 4].

As per claim 5, Pace et al teach the method for detecting electronic text communication distributed in bulk as recited in claim 1, wherein a match is determined from the comparing step even if the first fingerprint and the second fingerprint differ by a percentage [col. 2, lines 30-56 and col. 6, lines 2-17].

As per claim 6, Pace et al teach the method for detecting electronic text communication distributed in bulk as recited in claim 1; further comprising steps of determining network addresses for the first and second electronic text communications [col. 3, lines 7-20 and col. 6, lines 2 to col. 7, line 4]; and modifying the first threshold based upon the step of determining network addresses [6, lines 63 to col. 7, line 32].

As per claim 7, this is method claim with similar limitations as claim 1 above. Pace et al teach processing plurality of electronic text messages to produce a plurality of fingerprints (digital IDS) col. 3, lines 65 to col. 4, line 30 and col. 5, lines 14-29].

As per claim 8, Pace et al teach the method for detecting electronic text communication distributed in bulk as recited in claim 7, further comprising a step of filtering subsequent

Art Unit: 2153

electronic text communications similar to the electronic text communication [col. 6, lines 2-17 and col. 6, lines 63 to col. 7, line 17].

As per claim 9, Pace et al teach the method for detecting electronic text communication distributed in bulk as recited in claim 7, wherein the first listed processing step comprises a step of calculating a histogram where counts are determined for words in the electronic text communication [col. 6, lines 2-17 and col. 6, lines 63 to col. 7, line 17].

As per claim 10, Pace et al teach the method for detecting electronic text communication distributed in bulk as recited in claim 7, further comprising steps of:

determining if a character count of the electronic text communication exceeds a second threshold [col. 6, lines 2 to col. 7, line 4]; and

choosing a fingerprint algorithm based upon the step of determining if the character count of the electronic text communication exceeds the second threshold [col. 6, lines 2 to col. 7, line 4].

As per claim 11, Pace et al teach the method for detecting electronic text communication distributed 2 in bulk as recited in claim 7, wherein the electronic text communication is chosen from a group consisting of a chat room comment, an instant message, a

Art Unit: 2153

newsgroup posting, an electronic forum posting, a message board posting, and a classified advertisement [col. 1, lines 15-20 and col. 3, lines 22-27].

As per claim 12, Pace et al teach the method for detecting electronic text communication distributed 2 in bulk as recited in claim 7, further comprising steps of: 3 determining network addresses for the electronic text communication and 4 each of the subset [col. 3, lines 7-20 and col. 6, lines 2 to col. 7, line 4]; and

modifying the first threshold based upon the step of determining network addresses [col. 6, lines 63 to col. 7, line 32].

As per claim 13 Pace et al teach the method for blocking electronic text communication distributed in bulk (fig. 2), the method comprising steps of:

receiving an electronic text communication [email message are received col. 3, lines 33-41];
generating a fingerprint indicative of the electronic text communication [col. 4, lines 3-14 and 53-64];
beginning a time period in relation to the first listed receiving step [message Ids' arrival are time and recorded col. 6, lines 2-17];

receiving a plurality of electronic text communications [col. 6, lines 63 to col. 7, line 17];

Art Unit: 2153

generating a plurality of fingerprints corresponding to the plurality of electronic text communications [col. 3, lines 65 to col. 4, line 30 and col. 5, lines 14-29];

determining a subset of the plurality of electronic text communications that are similar to the electronic text communication [col. 2, lines 43-56 and col. 6, lines 2-17];

counting a size of the subset [col. 6, lines 63 to col. 7, line 17];

determining if the size during the time period reaches a first threshold [col. 5, lines 41 to col. 6, lines 17]; and filtering subsequent electronic text communications similar to the electronic text communication [col. 5, lines 41 to col. 6, lines 17].

As per claim 14, Pace et al teach the method for blocking electronic text communication distributed in bulk as recited in claim 13, wherein the first listed generating step comprises a step of calculating a histogram where counts are determined for words in the electronic text communication [col. 6, lines 2-65].

As per claim 16, Pace et al teach the method for blocking electronic text communication distributed in bulk as recited in claim 13, further comprising a step of determining if a character count of the electronic text communication exceeds a second threshold [col. 6, lines 2 to col. 7, line 4].

Art Unit: 2153

As per claim 17, Pace et al teach the method, for blocking electronic text communication distributed in bulk as recited in claim 16, further comprising a step of choosing a fingerprint algorithm based upon the step of determining if the character count of the electronic text communication exceeds the second threshold [col. 6, lines 2 to col. 7, line 4].

As per claim 18, Pace et al teach the method for blocking electronic text communication distributed in bulk as recited in claim 13, wherein the electronic text communication is chosen from a group consisting of a chat room comment, an instant message, a newsgroup posting, an electronic forum posting, a message board posting, and a classified advertisement [col. 1, lines 15-20 and col. 3, lines 22-27].

As per claim 20, Pace et al teach the method for blocking electronic text communication distributed in bulk as recited in claim 13, further comprising steps of:

determining network addresses for the electronic text communication and each of the subset [col. 3, lines 7-20 and col. 6, lines 2 to col. 7, line 4]; and

modifying the first threshold based upon the step of determining network addresses [6, lines 63 to col. 7, line 32].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pace et al USPN (6460050) in view of Cotton USPN (6330590).

As per claim 15, although Pace et al shows substantial features of the claimed invention, he does not explicitly show removing non-textual information from the electronic text communication. Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Pace et al, as evidenced by Cotten USPN. (6330590).

In analogous art, Cotten whose invention is about preventing delivery of unwanted bulk e-mail, disclose a system that removes (eliminates) non-textual information such as personalization and addressing portion from an electronic text communication [Col. 2, lines 16-27]. Giving the teaching of Cotten, a person of ordinary skill in the art would have readily recognized the

Art Unit: 2153

desirability and the advantage of modifying Pace et al by employing the system of Cotten in order to establish a signature identification code from the remaining portion [Col. 2, lines 6-65].

As per claim 19, Cotton teaches the invention, further comprising a step of removing everything from the electronic text communication except a message body [Col. 2, lines 18-27].

Conclusion

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 703-305-5971. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 703-305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Art Unit: 2153

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Yasin Barqadle

Art Unit 2153



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